

REMARKS

Responsive to the Office Action mailed November 24, 2006, Applicant provides the following. No claims have been amended. Claims 35-39 have been added without adding new matter. Thirty-nine (39) claims remain pending in the application: Claims 1-39. Reconsideration of claims 1-34 in view of the remarks below and consideration of new claims 35-39 is respectfully requested.

Claims fees are submitted herewith for five additional claims in excess of 20 claims. An appropriate fee for a one-month extension is also provided herewith. We note that this amendment is submitted within the one-month extended time period because the date of submission, Monday, March 26, 2007, is the first business day following the day of expiration of the one-month extension, Saturday, March 24, 2007.

By way of this amendment, Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues, it is respectfully requested that the Examiner telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Claim Rejections - 35 U.S.C. §103

1. Claims 1, 5, 7-14, 23 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,259,597 (Anzai et al.) in view of U.S. Patent No. 6,028,764 (Richardson et al.).

Regarding claim 1, it is acknowledged in the Office action, and Applicants agree, that Anzai fails to teach at least "a coupling portion adapted to removably couple the cover portion to the electronic device," as recited in claim 1 (see page 2 of the Office action). The Examiner asserts that it would have been obvious to modify Anzai with the teaching of Richardson to show that at least this element of claim 1 was taught by the combination of the references. Applicants respectfully traverse and submit that

claim 1 is not rendered obvious by the proposed combination of Anzai and Richardson at least because there is no proper motivation to modify Anzai with the teaching of Richardson.

MPEP 2143.01(I) requires that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Further, MPEP 2145(X)(D)(2) states that “[i]t is improper to combine references where the references teach away from their combination.”

Anzai teaches an electrical touch panel section 40 that is rotatably coupled by hinge mechanisms 22 to a portable electronic device, such as a notebook PC 10 (see Anzai, FIG. 1). Wiring lines 46A and 48A electrically couple the touch panel section 40 to the device via a touch panel control circuit 72 enabling the portable electronic device to receive electrical signals from the touch panel section 40 (col. 5, lines 3-9 and FIGS. 2 and 5). The touch panel section 40 allows the user to interact with the functionality of the portable electronic device, e.g., by functioning as a digitizer or tablet. When functioning as a digitizer, the touch panel section 40 is rotated toward the keyboard 24 of the portable electronic device to facilitate writing on the touch panel 40 while concurrently viewing the LCD 32 (col. 3, lines 51-52; col. 4, lines 29-42; and FIG. 4). In this mode, protrusion members 42 serve to prevent contact between the keyboard 24 and the touch panel section 40 (col. 3, lines 50-64). When the touch panel section 40 functions as a tablet, the touch panel 40 is rotated toward the LCD 32 to facilitate input operations by fingertip (such as with a standard touch-screen display) (col. 1, lines 13-18; col. 2, lines 16-20; col. 3, lines 35-36; and FIG. 3). In this mode, a latch 34 is used for fixing the touch panel section 40 to the cover 30 of the portable electronic device at a predetermined distance from the LCD 32 (col. 3, lines 34-41). As acknowledged in the Office action, there is no suggestion that the touch panel section 40 be removable in any

way. In fact, the touch panel section 40 is specifically designed to be “accommodated in a space between the flat panel display and the keyboard when a user is to carry the portable electronic device” (see col. 2, lines 23-28).

Richardson teaches a portable computer 10 having a display screen housing 14 that is detachably connected to the housing of the computer 12 (see Richardson, Abstract). Communication between the portable computer 10 and the display screen 18 occurs via wire connection, infrared signal or radio signal (col. 2, lines 3-13). The display screen housing 14 has two rigid U-shaped shafts 26 that protrude from the edge of the display screen housing 14 that connects to the computer housing 12 (FIGS. 2 and 5). These shafts 26 couple the display screen housing 14 to the computer housing 12 by being placed inside open rings 28 fixedly attached to the computer housing 12 (FIGS. 1-4; and col. 2, lines 28-35). “The ring 28 may apply a frictional force to the shaft 26 to allow the housing 14 to be fixed at various desired angular orientations with respect to the housing 12” (col. 2, lines 34-36). “When it is desired to remove the housing 14, the housing is simply rotated to the parallel position” relative to the housing 12 of the portable computer 10 (col. 2, lines 37-38). In this parallel position, one may remove the display housing 14 from the housing 12 by exerting a downward force on the display housing 14 relative to the housing 12. Accordingly, Richardson teaches a structure to connect and disconnect the *display housing 14* from the computer housing 12 in a way that the display housing 14 *continues to operate and function with the computer housing 12 when disconnected*.

There is no motivation or suggestion to make the touch panel section 40 of Anzai removable as the display screen housing 14 of Richardson is removable as required at least by MPEP 2143.01(I). First, the design of the portable electronic device indicates that the touch panel section 40 of Anzai was meant to be permanently integrated with the device and not removable. Anzai has specifically designed the touch panel section to be accommodated between the display and the keyboard when

not in use (see col. 2, lines 23-28 and col. 6, lines 8-10). The panel section 40 is also designed with a protrusion member 42 and a latch 34 so as not to damage or limit the operation of the display screen or the keyboard in use (e.g., see col. 3, lines 33-40 and 46-55). That is, the touch panel section is designed to be a permanent part of the electronic device. Allowing the touch panel section to be removable would make the touch panel section susceptible to being damaged or scratched (since it would not be protected between the display screen and the keyboard). This is in contrast to Richardson, where the separable parts each have a housing (i.e., the display 18 has a housing 14 and the computer 10 has a housing 12). Indeed, it is believed that if Anzai had intended the touch panel section 40 to be removable, Anzai would have included additional description and details to allow for such removability, but instead has gone to lengths to design the panel section to be permanently integrated.

Second, there is no motivation or suggestion to make the touch panel section 40 of Anzai removable as suggested by Richardson because, in operation, the panel 40 is meant to be positioned directly over the LCD display screen so as to allow user interaction with the LCD as with a touch screen. When the touch panel section 40 functions as a tablet, the touch panel 40 is rotated toward the LCD 32 to facilitate input operations by fingertip (such as with a standard touch-screen display) (see col. 1, lines 13-18; col. 2, lines 16-20; col. 3, lines 35-36; and FIG. 3) and is specifically held in place by the latch 34. Additionally, when used as a digitizer, the panel 40 must be positioned directly over the keyboard. If the touch panel section 40 is removed from the portable electronic device (while maintaining a functional connection with the computer), the panel 40 will not work as intended because the panel 40 must be directly over the LCD 32 in order for a user to be able to interact with the LCD 32 via fingertip operations and must be positioned over the keyboard to function as a digitizer. Thus, Anzai teaches away from any suggestion to modify the touch panel section 40 to be removable in the manner suggested by Richardson because removal of the panel 40 would prevent a user

from utilizing this touch-screen function and digitizer function.

On page 13 of the Office action, Applicant's argument that detaching the touch panel section 40 of Anzai would destroy the operability of the touch panel section 40 was addressed by stating, "it would have been obvious to one having ordinary skill in the art at the time of the invention to make the cover separable or detachable...since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art." This, however, is not the test for obviousness. MPEP 2143.01(III) states "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Further, MPEP 2143.01(IV) states "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' [i.e. "involves only routine skill in the art" (page 13 of the Office action)] at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references" (emphasis in MPEP). Nevertheless, no factual basis or motivation is provided to modify Anzai with the teachings of Richardson. Furthermore, Applicant provides several reasons above why there is no motivation and, indeed, why Anzai actually teaches away from the proposed modification.

For all of the above reasons, one of ordinary skill in the art would not be motivated to make the touch panel section 40 of Anzai removable as the display screen housing 14 of Richardson is removable. Thus, due at least to the design of Anzai and the fact that the touch panel section 40 must be either directly in front of the LCD 32 or directly over the keyboard to function as it was intended, it is inherent that the touch panel section 40 of Anzai is not removable and that Anzai teaches away from any suggestion to make it removable.

Additionally, MPEP 2143.01(V) also states that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In this case, if the panel 40 was removed, a user could not even utilize the touch screen feature of the touch panel section 40 in combination with the LCD 32 or use it as a digitizer – its principal intended purposes. Thus, making the touch panel section 40 removable would render the Anzai device unsatisfactory for its intended purpose.

Still further, MPEP 2143.01(VI) states “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” Removing the touch panel section 40 from the portable electronic device, in accordance with the proposed modification, would change the principle of operation of Anzai because when operating in the touch screen mode, the touch panel section 40 is directly over the LCD 32 so as to allow a user to interact with the LCD 32 as with a touch screen. Additionally, the panel 40 would not work as a digitizer positioned over the keyboard as intended. Therefore, the references are not sufficient to render the claims *prima facie* obvious at least per MPEP 2143.01(VI) because the combination would change the principle of operation of Anzai.

It has been shown above that there is no motivation to modify Anzai in view of the teaching of Richardson. However, even if Anzai were modified as suggested, claim 1 is not rendered obvious because this combination does not at least teach all of the elements of claim 1. MPEP 2143 states “to establish a *prima facie* case of obviousness...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Further, MPEP 2141.02(VI) states that “[a] prior art reference must be considered in its entirety, i.e., as a whole” (emphasis in MPEP). The Examiner asserts that “Richardson is only used to provide the added limitation of a

coupling portion, whereby a top portion of a computer base is capable of being removed or detached” (page 3 of the Office action). In other words, the Examiner is considering a single feature of Richardson, a coupling portion, and applying it generally to a generic “top portion of a computer base.” When viewed as a whole, however, Richardson clearly teaches a removable display (See Richardson, Abstract and FIG. 2) with a removable coupling structure and data connection that allows the display to continue to work when removed. Thus, when applying the teaching of Richardson to Anzai, the cover 30 of Anzai containing the LCD 32 (i.e., the display) would be made removable. The proposed combination does not teach a user input panel situated between a display and a keyboard (such as the touch panel section 40 of Anzai) as being removable. Nevertheless, the Examiner has asserted that the touch panel section 40 of Anzai is equivalent to “a cover portion” of claim 1 (page 2 of the Office action). Thus, the combination of Anzai and Richardson does not teach at least “a coupling portion adapted to removably couple the cover portion to the electronic device” (emphasis added), as recited in claim 1, at least because the combination does not teach making the touch panel section 40 of Anzai removable. Because the combination of Anzai and Richardson does not at least teach all of the elements of claim 1, as required at least by MPEP 2143, a *prima facie* case of obvious has not been made.

For at least the aforementioned reasons, there is no motivation to modify Anzai in view of Richardson. Further, even if there were motivation to combine them, the combination would not teach all of the elements of claim 1. Thus, a *prima facie* case of obviousness has not been made. Therefore, Applicants respectfully submit that the rejection of independent claim 1, and any claims dependent thereon, is overcome and should be withdrawn. Applicants respectfully submit that the rejection of claims 1, 5, 7-14 and 33 is overcome and should be withdrawn.

Regarding independent claim 10, Applicants respectfully submit that at least for the reasons given above with respect to claim 1, the rejection of claim 10 is

overcome and should be withdrawn. Furthermore, claim 10 recites “a piece adapted to receive a portion of the post such that the post is rotatable within the piece, the piece further adapted to removably and rigidly couple to the electronic device; wherein the piece comprises a clip that can be removably attached to a portion of the electronic device” (emphasis added). The Examiner asserts that the open ring 28 of Richardson is equivalent to “the piece” (page 4 of the Office action). The open ring 28, however, is not “adapted to removably...couple to the electronic device,” as claimed. Instead, the open ring 28 of Richardson is fixed to the computer housing 12 and is not removable from the housing 12. Furthermore, the Examiner states “Richardson et al. teaches a post (26) removably coupled to a piece (28)” (page 4 of the Office action). In contrast, claim 10 recites “a piece adapted to receive a portion of the post” and “the piece further adapted to removably and rigidly couple to the electronic device.” In other words, Richardson teaches a post removably coupled to a piece, whereas claim 10 recites a piece that both receives a post and is adapted to be removably coupled to an electronic device.

MPEP 2143 states “to establish a *prima facie* case of obviousness...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Because the proposed combination of Anzai and Richardson does not teach at least the limitation “the piece further adapted to removably and rigidly couple to the electronic device,” as recited in claim 10, a *prima facie* case of obviousness has not been made with respect to claim 10.

Additionally, the Examiner states:

Although, Richardson et al. teaches a post (26) being removably coupled to a piece (28), in opposite operation from the instant application, it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the post to the top cover and the post to the base of the computer, since it has been held that a mere reversal of the essential working part of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167. (page 4, last paragraph, of the Office action).

However, the Examiner must provide motivation or reason for one skilled in the art to make the rearrangement that is asserted to be obvious.

MPEP 2144.04(VI)(C) states that “[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.” No factual basis or motivation is provided to show why it would have been obvious to rearrange the parts of Richardson in a manner consistent with claim 10.

Thus, for at least the aforementioned reasons, the proposed combination of Anzai and Richardson does not teach, or render obvious, at least the limitation “the piece further adapted to removably and rigidly couple to the electronic device,” as recited in claim 10. Furthermore, for at least the reasons stated above with respect to claim 1, there is no motivation to modify Anzai in view of Richardson. Thus, a *prima facie* case of obviousness has not been made. Therefore, Applicants respectfully submit that the rejection of independent claim 10 is overcome and should be withdrawn.

Regarding claim 23, Applicants respectfully submit that at least for all of the reasons given above with respect to claims 1 and 10, the rejection of claim 23 is overcome and should be withdrawn. Additionally, claim 23 recites “the cover adapted to limit an angle of view of the display screen through the cover.” Nothing in Anzai or Richardson teaches this limitation. It is assumed the Examiner meant only to reject claim 23 in view of Anzai and Richardson, in further view of U.S. Patent No. 5,204,160 (Rouser), and not in view of Anzai and Richardson alone. Nevertheless, Applicants respectfully submit that the rejection of claim 23 in view of Anzai and Richardson is overcome and should be withdrawn because the combination of Anzai and Richardson does not teach at least the limitation “the cover to limit an angle of view of the display

screen through the cover,” or the limitation “the piece further adapted to removably and rigidly couple to the computer,” as recited in claim 23. Furthermore, for the reasons stated above with respect to claim 1, there is no motivation to modify Anzai in view of Richardson.

2. Claims 2-4, 15-18, 20-32 and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Anzai in view of Richardson, and further in view of U.S. Patent No. 5,204,160 (Rouser).

Independent claims 15, 23 and 27 recite elements similar to those recited in claim 1. It has been shown above that claim 1 is not rendered obvious in view of the proposed combination of Anzai and Richardson. Thus, for reasons discussed above with respect to the rejection of claim 1, claims 15, 23 and 27 are also not rendered obvious in view of Anzai in combination with Richardson. The additional reference, Rouser, describes a light collimating film and provides no additional teaching to support modifying the touch panel section of Anzai to make it removable. Thus, Applicants respectfully submit that the rejection of claims 15, 23 and 27, and any claims dependent thereon, is overcome and should be withdrawn. Therefore, Applicants respectfully submit that the rejection of claims 2-4 (which depend from claim 1) and claims 15-18, 20-32 and 34 is overcome and should be withdrawn.

3. Claims 6 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Anzai in view of Richardson, and further in view of Rouser and U.S. Patent No. 5,982,617 (Haley et al.).

Dependent claims 6 and 19 depend from claims 1 and 15, respectively, which have which have been shown above not to be rendered obvious by the proposed combination of references. The additional reference, Haley, describes a cooling system for integrated circuit chips in a portable computer lid assembly and provides no

additional teaching to render claims 1 and 15 obvious. Therefore, Applicants respectfully submit that the rejection of claims 6 and 19 is overcome and should be withdrawn.

New Claims

4. Newly submitted claims 35-39 are believed to be allowable because they are directed to that which is not shown or suggested in the prior art. In particular, Richardson's removable coupling structure is removable only when the housing 12 and the display housing 14 are parallel (see col. 2, lines 37-41 or Richardson).

Support for new claims 35-39 can be found at least at page 6, lines 19-22 and page 11, lines 28-29 of the specification and FIGS. 1-4 and 9-15.

CONCLUSION

Applicant submits that the above amendments and remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,

Dated: March 26, 2007

/scott j. menghini/

Scott J. Menghini
Reg. No. 42,880
Attorney for Applicant
(858) 552-1311

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
120 So. LaSalle Street, Ste. 1600
Chicago, IL 60603

Direct telephone inquiries to:
Scott J. Menghini
(858) 552-1311
San Diego, California Office of
FITCH, EVEN, TABIN & FLANNERY